

REMARKS

Claims 1-7 have been rejected by the Examiner under 35 USC 112, first paragraph, as not providing enablement for a fender limited only by properties. The Examiner argues that the specification does not enable any person skilled in the art to which it pertains to make and use the invention commensurate in scope with the claims. This rejection is respectfully traversed.

First of all, it should be noted that claims 8 and 9 were added to the present application by the last Amendment and the Examiner has not addressed claims 8 and 9 in his most recent Office Action letter. Since the Examiner did not consider claims 8 and 9, it could be presumed that the Examiner considers claims 8 and 9 allowable, or in any event, some explanation concerning the status of claims 8 and 9 should be forthcoming from the Examiner.

In connection with the Examiner's rejection of claims 1-7 under 35 USC 112, first paragraph, it should be noted that the present application clearly points out that conventional shock-absorbing fenders for marine vessels have not, heretofore, given adequate consideration as to how such fenders function with variations in environmental temperature. The present application recognizes this problem and solves this problem by identifying various properties which a base rubber material must possess in order to function as a shock-absorbing fender in a variety of environmental conditions. Thus, the present invention, has determined how materials of rubber composition must be characterized in order to be effective as a shock-absorbing fender adapted

for environmental changes such as, for example, temperature variations. It is believed that the claims of the present application do, in fact, by identifying the specific parameters and ranges of said parameters, enable any person skilled in the art to select a rubber composition which would satisfy the needs of a fender that would function as a shock absorber under the extremes of environmental conditions. As noted on page 23 of the present application, ordinary rubber components are usable as the base rubber material for the shock-absorbing fender of the present invention, however, the base rubber which is selected must contain the necessary tensile strength, elongation, tear strength, compression set and the like, which may be necessary for achieving the compressive properties of the fender as defined in the claims of the present application. Thus, it is believed that the claims provide the necessary enablement to select the base rubber material which will fulfill the needs of the shock-absorbing fender of the present invention.

In paragraph 3 of the Examiner's Office Action, the Examiner states that the 35 USC 112, first paragraph, rejection as set forth in Paper No. 4 is considered proper because the case law has well established that single means claims are not commensurate in scope with the enabling disclosure. The Examiner states that the Applicant has failed to argue that the claims are not single means claims. The position of the Examiner is not understood. The use of "a single means claim" rejection in the present situation is inappropriate inasmuch as the claims of the present application are not written as "means claims" since the claims do not use the traditional "means for" terminology, but

rather are written as article claims which use the rubber composition having specific properties for achieving the desired result. Thus, the present claims do, in fact, recite more than a mere means plus function but rather recite the specific properties of a rubber composition which achieves a desired function. The relevance of the "single means" argument and the In re Hyatt 218 USPQ 195 citation is not understood in the context of the product claims of the present application.

Claims 1-7 have been rejected by the Examiner under 35 USC 102(b) or (e) as anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over Tajima et al., Hashimoto, Dailey or Nakahira. This rejection is respectfully traversed.

The Examiner, in rejecting the claims of the present application, has recognized that the prior art fails to disclose the relationship as set forth in the claims. However, the Examiner feels that this is not persuasive since the Applicant has not shown or alleged that the prior art does not inherently possess properties which anticipate or render obvious the properties as claimed. Basically, the Examiner is taking the position that since the prior art relied upon in the Office Action letter contains the same or similar rubber compositions as in the present invention, that the references, for example, the Tajima et al. patent, are considered to inherently possess the same properties as that of the present invention and accordingly anticipate or render obvious the claimed invention. The Examiner argues that it is *prima facie* obvious to optimize properties by manipulating the ingredients in amounts of the rubber

composition. However, it is the Applicant's position that, first of all, the present invention identifies certain parameters and certain properties of a rubber composition which have been identified as affecting the usability of a rubber fender for functioning as a shock absorber in all environmental conditions. The prior art does not even remotely suggest what properties must be considered when developing an environmentally functioning shock absorber. Next, the present invention has determined the mete and bounds, that is, the ranges of the identified parameters which would enable one skilled in the art to select a rubber composition which would satisfy the needs of a fender that would function as a shock absorber under the extremes of environmental conditions. Here again, the prior art fails in all aspects.

As noted on page 23 of the present application, ordinary rubber components are usable as the base rubber material for the shock-absorbing fender of the present invention. However, the base rubber which is selected must contain the necessary tensile strength, elongation, tear strength, compression set and the like, which may be necessary for achieving the compressive properties of the fender as defined in the claims of the present application.

The claims of the present application do not merely contain a recitation of generic properties, such as for example, higher or low elastic modulus, higher or low rigidity modulus, or the like, but rather have identified a specific rate of change of elastic modulus and a specific rate of change of rigidity modulus, etc., and thus any rubber composition which would fall within the

parameter as defined in the claims of the present application but also define the particular rubber compositions that can be used in the present invention. Thus, the present invention has discovered, not optimized, specific parameters that make a marine fender particularly effective when operating in a variety of environmental conditions, such as for example, high and low temperature conditions.

The Applicant is not optimizing the teachings of the prior art, because the prior art does not recognize the parameters defined by the present invention nor the problems solved by the Applicant's recognition of these parameters.

It is the Applicant's position that the USPTO has the burden of showing unpatentability of the claims and that the burden is not shifted to the Applicant as alleged by the Examiner. Accordingly, reconsideration of the rejections and the allowance of claims 1-7 of the present application are respectfully requested. In addition, claims 8 and 9 which were added to the present application in the Applicant's previous response to the USPTO are also considered to be allowable and if the Examiner feels otherwise, the Applicant should have the opportunity to respond to any rejection or objection raised with respect thereto. Claim 8 has been cancelled in this proposed Amendment.

Accordingly, reconsideration of the rejections and objections and allowance of all of the claims of the present application are respectfully requested.

Conclusion

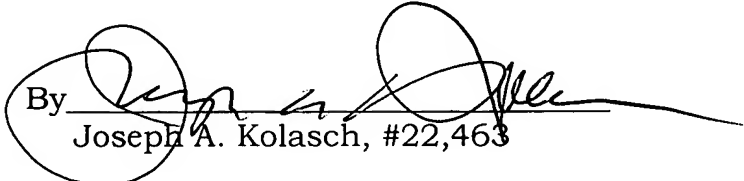
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Joseph A. Kolasch (Reg. No. 22,463) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant respectfully petitions for a one-month extension of time for filing a reply in connection with the present application, and the required fee of \$110 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Joseph A. Kolasch, #22,463

JAK/njp
2809-0121P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000